



Atty. Dkt. No. 034536-0741

1 FLS

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Joseph SCHLESSINGER et al.

Title: NOVEL RECEPTOR-TYPE  
PHOSPHOTYROSINE  
PHOSPHATOASE-KAPPA

Appl. No.: 09/887,669

Filing Date: 10/1/2001

Examiner: Michael T. Brannock

Art Unit: 1646

**RESPONSE TO RESTRICTION REQUIREMENT**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the restriction requirement set forth in the Office Action mailed June 9, 2004, applicants hereby provisionally elect Group II (Claims 5-8, 11, and 12) for examination with traverse. Applicants also elect the species of antibodies that specifically recognize the extracellular domain with traverse. Because this response is filed before the end of the one-month shortened statutory period, i.e., July 9, 2004, Applicants consider this paper timely filed.

The examiner has required restriction between Group I (Claims 1-4, 9, and 10) drawn to antibodies that bind a polypeptide of SEQ ID NO: 1, and Group II (Claims 5-8, 11, and 12) drawn to antibodies that bind a polypeptide of SEQ ID NO: 2. The examiner also believes that claims 1-12 "are generic to a plurality of disclosed patentably distinct species that specifically recognize" different peptide domains, and therefore, the examiner requires election of a single species.

Applicants respectfully disagree with the examiner. Applicants believe there is no undue burden on the examiner to examine both SEQ ID NO: 1 and SEQ ID NO: 2, and note

that the Patent Office has classified each invention in the same class (530) and subclass (388.22). In regard to the species election, applicants submit that there is no undue burden on the examiner to search all antibodies that bind a polypeptide of SEQ ID NO:2. Thus, applicants request that the examiner withdrawn the election of species and examine the claims of Group II. MPEP 803 recites that if “the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

However, if the examiner maintains the species election, following the procedure of MPEP § 803.02, after an elected species is found allowable, the examiner proceeds to examine the next species of the generic claim. If all the species of the claim are ultimately found allowable, then the entire generic claim is allowed.

In regard to requiring the numerous election of species, the examiner is reminded that upon the allowance of a generic claim, Applicants are entitled to consideration of claims to additional species which are written in dependent form or contain all of the limitations of an allowed generic claim as provided by 37 C.F.R. §1.141. Applicants respectfully request that the examiner reconsider this restriction requirement in view of the above arguments, and examiner all of the claims.

Applicants, of course, reserve the right to file one or more divisional applications covering the subject matter of the non-elected claims and non-elected subject matter of claims. Receipt of the initial Office Action on the merits is awaited.

If the examiner believes that personal communication will expedite prosecution of this application, the examiner is invited to telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of

papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R.  
§1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date July 9, 2004

FOLEY & LARDNER LLP  
Washington Harbour  
3000 K Street, N.W., Suite 500  
Washington, D.C. 20007-5143  
Telephone: (202) 672-5475  
Facsimile: (202) 672-5399

By Beth A. Burrous Reg. No. 34,485  
*for* Beth A. Burrous  
Attorney for Applicant  
Registration No. 35,087